

Remarks

The non-final Office Action dated August 22, 2008 lists the following rejections: claims 1-4, 8-18, and 22-28 stand rejected under 35 U.S.C. § 103(a) over Cote *et al.* (U.S. Patent Pub. No. 2004/0234250) in view of Binford, Jr. *et al.* (U.S. Patent No. 6,285,405) and in further view of Pires (U.S. Patent No. 4,180,829); and claims 5-7 and 19-21 stand rejected under 35 U.S.C. § 103(a) over Cote, Binford, Jr. and Pires, and further in view of Takehiko *et al.* (U.S. Patent No. 6,741,795). Claims 29-56 are noted as being allowed. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 103(a) rejections of claims 1-28 (each of which is based upon Cote in view of Pires) because the Examiner fails to provide a valid reason for the proposed modification of the Cote reference. Applicant notes that the Examiner still has not specified how the seemingly unrelated teachings of Pires concerning two TV signals are to be combined with Cote's teachings directed to a Karaoke generation involving an audio signal and a video signal. In an effort to facilitate prosecution, Applicant addresses the impropriety of three possible combinations of the Cote and Pires references below. Should the Examiner have envisioned some other as of yet unidentified combination Applicant requests clarification, to which Applicant should be afforded an opportunity to respond prior to a final rejection. *See, e.g.,* M.P.E.P. § 706.07.

As a first possibility, should the Examiner be proposing to replace Cote's audio and video signals with the two TV signals of Pires, such a modification would render Cote unsatisfactory for its intended purpose of Karaoke generation. *See, e.g.,* M.P.E.P. § 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."). Applicant submits that such a modification would render Cote unsatisfactory for its intended purpose of Karaoke generation since Cote would no longer have the requisite audio and video signals. *See, e.g.,* Figure 16 and Paragraphs 0156-0159. Thus, there is no motivation for the skilled artisan to modify Cote in this manner.

As a second possibility, should the Examiner be proposing to somehow use Pires' phase matching of first and second television signals (*i.e.*, two video signals) with Cote's audio and video signals, the Examiner fails to provide a valid reason why the skilled artisan would combine the unrelated teachings of the Cote and Pires references in this manner. This approach is contrary to the requirements of § 103 and relevant law. The Examiner states that it would be obvious to the skilled artisan to add "Pires' phase adjustment to Cote's system in order to allow the user to adjust phase of each television signal ... to assure that the whole display is uniform as to hue and horizontal placement".¹ The cited portions of Cote, however, do not have multiple TV signals but instead teach an audio signal and a video signal as discussed above. As the Cote reference does not have multiple television signals that require synchronization, the Examiner's alleged reason to combine is inapplicable to the Cote reference. For example, Cote's audio signal does not have a "hue" or a "horizontal placement" to adjust relative to Cote's video signal. As such, the Examiner's alleged reason to combine is illogical. Thus, the Examiner has not presented any reason why the skilled artisan would combine the cited teachings of the Pires reference with Cote's karaoke system.

As a third possibility, should the Examiner be proposing to modify Cote to have a second video signal, Applicant submits that the Examiner's modification is creating the very problem which is asserted as the reason why the skilled artisan would combine these references.

In view of the above, the Examiner fails to provide any reason why the skilled artisan would combine the unrelated teachings of the Cote and Pires references. Accordingly, the § 103(a) rejections of claims 1-28 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-28 (each of which is based upon Cote in view of Binford) because the Examiner fails to provide a valid reason for the proposed combination of these references. The Examiner apparently asserts that the skilled artisan would modify the Cote reference to synchronize Cote's audio and video signals at source 300 simply so that these signals are synchronized at the source.

¹ The cited portions of Pires teach adjusting the phase of a first TV signal displayed on the top half of the monitor relative to the phase of a second TV signal displayed on the bottom half of the monitor so that the two TV signals are synchronized. *See, e.g.*, Figure 4 and Col. 4:44 to Col. 5:7.

See, e.g., page 12:14-20 of the instant Office Action. The only other supposed reason to combine the Cote and Binford references presented by the Examiner is derived solely from the Pires reference and is entirely inapplicable to why the skilled artisan would combine Cote and Binford as was discussed by Applicant starting on page 14 of the previous Response, hereby incorporated by reference in its entirety. The Binford reference, however, synchronizes audio and video signals for reasons that are not present in the Cote reference as is acknowledged by the Examiner. *See, e.g.*, page 12:14-20 of the instant Office Action. Specifically, Binford teaches synchronizing audio and video signals that require different amounts of time to code/decode and transmit over a network 114 between various endpoints by measuring the actual video encoding and video decoding delay and introduces the measured delay in the audio encoding and audio decoding routines. *See, e.g.*, Col. 2:1-11, Col. 4:40-50 and Col. 5:44-49. In contrast, the cited portions of Cote are directed to Karaoke generation that does not involve any encoding/decoding of audio and video signals and or any data transmission over a network between endpoints as in Binford. As such, Binford synchronization techniques are inapplicable to the Cote reference.

Moreover, Applicant submits that combining synchronization techniques relating to encoding/decoding of audio and video signals into Cote's source 300, which does not perform any encoding/decoding of audio and video signals, would render the Cote reference inoperable. *See, e.g.*, M.P.E.P. § 2143.01 and *In re Gordon* discussed above. As such, there is no motivation for the skilled artisan to combine these references in the manner proposed by the examiner.

In view of the above, the Examiner fails to provide any reason why the skilled artisan would combine the unrelated teachings of the Cote and Binford references. Accordingly, the § 103(a) rejections of claims 1-28 are improper and Applicant requests that they be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (914) 860-4296 (or the undersigned).

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